

## REMARKS

### **Interview summary**

Applicant thanks the examiner for the interview of July 28, 2003 in which were discussed the section 101 rejection and the section 112 rejection. Regrettably, no agreement was reached regarding the section 101 rejection. However, the Examiner considered the deletion of references to "building" in claims 58 and 64 to overcome the section 112 rejection.

### **Section 112 rejection**

Claims 58 and 64 stand rejected under section 112 as being indefinite because they are directed to "buildings not present in the independent claims." In response, Applicant proposes an amendment along the lines of that discussed in the interview. Applicant requests entry of the foregoing amendments to eliminate the need to address the section 112 rejection on appeal.

The foregoing amendment is made out of a sense of expediency and is not to be construed as an admission that Applicant considers the claims in their present form to be indefinite.

Applicant also amends certain dependent claims to correct minor grammatical errors.

### **Obviousness-type double patenting**

Upon resolution of the section 101 double-patenting rejection, Applicant proposes to provide a terminal disclaimer.

### **Statutory double-patenting**

For convenience, the following text shows amendments that must be made to claim 1 of *Newville* to arrive at pending claim 1.

1. A method of providing video information to a display monitor ~~within an elevator located in a building~~, the method comprising:
  - receiving first data defining a category of video information, ~~the first data being source non-specific;~~
  - receiving second data, associated with the category of video information and defining at least one source of the video information; and

retrieving from the source, over a data communications path, and on the basis of first data and second data, the video information to be displayed on the monitor ~~with the elevator.~~

Based on the interview, the Examiner appears to agree that claim 1 of *Newville* and pending claim 1 cover different subject matter. By itself, this is enough to obviate the double-patenting rejection.<sup>1</sup>

However, in maintaining the propriety of the statutory double-patenting rejection, the Examiner's position appears to be that: (1) the specification does not explicitly teach the placement of the display in a location other than the elevator; and (2) that the limitation of an elevator is added back in by dependent claims. According to the Examiner, these two facts mean that despite their clear textual differences, pending claim 1 and claim 1 of *Newville* somehow manage to cover *identical* subject matter.

To the extent that a dependent claim adds back the limitation of an elevator, there may be a basis for a statutory double-patenting rejection of only that particular dependent claim. However, the Examiner has not identified any such claims.

Applicant fails to see the relevance, to a statutory double-patenting rejection, of whether or not the specification teaches the placement of a display in a location other than the elevator. All that matters in a statutory double-patenting rejection is whether or not the issued claim and the pending claim recite the same subject matter. It is evident on their face, and in fact the Examiner appears to agree, that they do not do so.

The first paragraph of section 112 requires that the *best* mode be disclosed. This choice of words in the statute clearly implies that Congress recognized that: (1) there exist modes *other* than the best mode for practicing an invention; and (2) that the claimed invention can cover embodiments beyond what are expressly in the specification. Applicant notes that there is no

<sup>1</sup> In re Kaplan, 789 F.2d 1574 (CAFC 1986) ("That a claim in a second patent or patent application 'dominates' subject matter claimed in a first patent does not, by itself, give rise to double-patenting."); MPEP 804 II(A) "[a] reliable test for double-patenting under 35 USC 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent"

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legal requirement to describe every possible mode for practicing a claimed invention. Therefore, the Examiner's position that there is no teaching of, for example, placing a display in a lobby, has no relevance to a statutory double-patenting rejection.

The Examiner appears to misunderstand the distinction between *adding* a limitation and *removing* a limitation. An amendment *adding* a limitation on the environment would require support for that limitation in the specification. Whether or not a limitation can be *removed* depends on whether there exists prior art that anticipates or renders obvious the resulting claim.

In this case, Applicant is *removing* a limitation. Yet, the Examiner draws attention to the absence of a teaching in the specification, almost as if Applicant were adding, rather than removing a limitation. In view of this error, Applicant requests withdrawal of the statutory double-patenting rejection.

No additional fees are believed to be due in connection with the filing of this reply. However, to the extent fees are due, please adjust our deposit account 06-1050.

Respectfully submitted,

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